

HOGAN LOVELLS US LLP
Jennifer M. Lantz (Bar No. 202252)
Christian E. Mammen (Bar No. 188454)
James R. Cady (Bar No. 213337)
4085 Campbell Avenue, Suite 100
Menlo Park, CA 94025
Telephone: (650) 463-4000
Facsimile: (650) 463-4199
jennifer.lantz@hoganlovells.com

Attorneys for Plaintiff and Counterdefendant
EBAY INC., a Delaware corporation,

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
SAN FRANCISCO DIVISION

EBAY INC., a Delaware corporation,

Plaintiff,

v.

DOTCOM RETAIL, LIMITED, a United
Kingdom company; BEAUTYBAY.COM
LIMITED, a United Kingdom company,

Defendant.

DOTCOM RETAIL LIMITED, a United
Kingdom company; BEAUTYBAY.COM,
LIMITED, a United Kingdom company,

Counterclaimants,

v.

EBAY INC., a Delaware corporation,

Counterdefendant.

Case No. CV-13-02853-SC

**JOINT CASE MANAGEMENT
CONFERENCE STATEMENT**

Trial Date: None Set

Jury Trial Requested

1 Plaintiff eBay Inc. (“Plaintiff” or “eBay”) and Defendants Dotcom Retail, Limited
2 (“Dotcom”) and BeautyBay.com Limited (“BeautyBay”) (collectively, “Defendants”) submit this
3 joint Case Management Conference Statement pursuant to Fed. R. Civ. P. 26, Civil L.R. 16-9, and
4 the Court’s Order dated October 9, 2013 (Dkt. No. 24).

5 **I. JURISDICTION AND SERVICE**

6 **A. Jurisdiction**

7 This Court has subject matter jurisdiction over this matter pursuant to 15 U.S.C. § 1121
8 and 28 U.S.C. §§ 1331 and 1338(a) and (b), and has supplemental jurisdiction under 28 U.S.C. §
9 1367(a) over eBay's claims under California law.

10 Plaintiff contends that Defendants are subject to personal jurisdiction in this district
11 because they conduct or have conducted business in the State of California; they operate the
12 beautybay.com website targeting and selling products to consumers in California and in this
13 district; have sold and shipped products into California; and have agreements with vendors and
14 suppliers in this district for products that are sold on their website.

15 Plaintiff contends that venue is proper in this district under 28 U.S.C. §1391. Defendants
16 transact business in or solicit business from this district and may otherwise be found here, and a
17 substantial part of the events giving rise to this litigation occurred in the Northern District of
18 California.

19 Without agreeing to Plaintiff’s contentions, Defendants do not object to personal
20 jurisdiction or venue in this district.

21 **B. Service**

22 Service has been made on all parties.

23 **II. FACTS**

24 **A. Claims**

25 eBay has operated its ebay.com website under the EBAY name and mark continuously
26 since September of 1995 in connection with its services of providing an online marketplace for
27 buyers and sellers to buy, sell, bid on, and/or trade goods and services. Since that time, eBay has
28

1 evolved into a global technology company that enables commerce by providing online platforms,
2 tools and services to help individuals and small, medium and large merchants around the globe
3 engage in online and mobile commerce. In addition to the common law rights eBay claims in the
4 mark, eBay owns multiple federal US applications and registrations for the EBAY mark and
5 marks incorporating the EBAY mark (together the "EBAY Marks"), a number of which have had
6 Declarations of Use and Incontestability accepted by the USPTO.

7 Defendants Dotcom Retail Limited and BeautyBay.com Limited are United Kingdom-
8 based companies that have been retailing health and beauty products online since 1999. In or
9 around 2002, Dotcom acquired the domain name www.beautybay.com, which it has been using to
10 retail its products since approximately 2005. Defendants have also used the marks
11 "FragranceBay" and "ClearanceBay" since 1999. Defendants used the mark CLEARANCEBAY
12 for a time on the beautybay.com website. That use has been discontinued.

13 On October 23, 2009, Defendant Dotcom applied to register the mark BEAUTY BAY
14 with the United States Patent and Trademark Office ("USPTO") in connection with "retail store
15 services in the field of fragrances, perfume, toiletries, cosmetics, soaps, shampoos, hair care
16 preparations, skin care preparations, essential oils, sun care and tanning preparations," in
17 International Class 35. In December 2010, eBay filed a Notice of Opposition with the USPTO,
18 objecting to Defendants' attempt to register the BEAUTY BAY mark. That opposition is pending.

19 On June 20, 2013, eBay filed this action seeking a judgment that Defendants have
20 infringed and diluted eBay's trademark EBAY®, as well as violated state law and the common
21 law doctrines of passing off and unfair competition. eBay seeks injunctive relief and damages to
22 the extent permitted by law.

23 **B. Counterclaims**

24 Dotcom and Beautybay have filed Counterclaims seeking declarative relief affirming their
25 non-liability and their rights to the BeautyBayFragranceBay and ClearanceBay marks.

26 **C. Case Status**

27 eBay filed its complaint in this case on June 20, 2013. Defendants filed their answer and
28

1 counterclaim on September 30, 2013. eBay filed its answer to Defendants' counterclaim for
 2 declaratory relief on October 30, 2013. The parties have conducted the conference required by
 3 Federal Rule of Civil Procedure 26. Neither party has served discovery to date.

4 **D. Parties**

5 Plaintiff eBay is a Delaware corporation having its principal place of business at 2145
 6 Hamilton Avenue, San Jose, California 95125. eBay is one of the world's foremost e-commerce
 7 and online marketplaces.

8 Defendant Dotcom is a United Kingdom company with its headquarters in the United
 9 Kingdom at Davrom House, 21 Lyons Road, Manchester. Dotcom shares in the ownership and
 10 operation of the BEAUTYBAY business, and is listed as the owner of the domain name
 11 www.beautybay.com and pending federal trademark application for the BEAUTY BAY mark.

12 Defendant BeautyBay is a wholly-owned subsidiary of Dotcom. BeautyBay shares in the
 13 ownership and/or operation of the BEAUTYBAY business and the beautybay.com website, and
 14 "BeautyBay.com Ltd." is listed on the beautybay.com website as its owner.

15 **III. LEGAL ISSUES**

16 Plaintiff eBay believes that the key legal issues include the following subjects:

- 17 (i) Whether Defendants' marks dilute eBay's famous "EBAY" mark;
- 18 (ii) Whether Defendants' marks are likely to be confused with eBay's famous
 19 "EBAY" mark;
- 20 (iii) Whether Defendants' marks have caused injury to eBay under California state or
 21 common law causes of action;
- 22 (iv) Whether Defendants' acts constitute trade name infringement under California
 23 state law or common law;
- 24 (v) Appropriate relief due to eBay, including injunctive and monetary relief.

25 Defendants believe that the key legal issues include the following subjects:

- 26 (i) Whether Plaintiff's claims are barred by laches.
- 27 (ii) Whether eBay's EBAY mark is protectable;

(iii) Whether eBay can foreclose any online business from using any mark that includes a generic term plus the word "Bay."

(iv) Whether eBay's EBAY mark is strong;

(v) Whether Defendants' marks dilute eBay's mark;

(vi) Whether Defendants' marks are likely to be confused with eBay's mark;

(vii) Whether Plaintiff's bad acts have barred its claims;

(viii) Whether Defendants have infringed Plaintiff's trade name;

(ix) Whether Plaintiff has suffered injury;

(x) Whether Plaintiff is entitled to any relief.

IV. SIGNIFICANT MOTIONS

Currently there are no pending motions in this case. Previously, the parties filed a stipulation to move the date of the Case Management Conference until or after November 11, 2013 (Doc. 16), and that stipulation was granted (Doc. 17). The parties also filed a stipulation to extend the time for eBay to file an answer to Defendants' counterclaim (Doc. 25), which was granted (Doc. 28). The parties do not currently anticipate filing any early motions, and anticipate filing dispositive motions at the appropriate time pursuant to the schedule to be set by this Court.

V. AMENDMENT OF PLEADINGS

The parties do not currently anticipate any amendment of the pleadings.

VI. EVIDENCE PRESERVATION

The parties have reviewed the Guidelines Relating to the Discovery of Electronically Stored Information, and the parties have met and conferred pursuant to Fed. R. Civ. P. 26(f) regarding reasonable and proportionate steps taken to preserve evidence relevant to the issues reasonably evident in this action. The parties have instituted means to preserve evidence.

VII. DISCLOSURES

The parties have not yet exchanged initial disclosures pursuant to Fed. R. Civ. P. 26(a). Initial disclosures are currently anticipated to be exchanged on December 11, 2013.

VIII. DISCOVERY

1 The parties have not yet taken discovery in this matter. The parties do not request any
2 variations from the discovery limits set forth in the Federal Rules. The parties anticipate taking
3 standard forms of discovery, including depositions, interrogatories and document requests. The
4 parties have discussed entering into a stipulated e-discovery order and will continue to discuss
5 such an order as needed.

6 **IX. RELATED CASES**

7 There is a related proceeding in the Trademark Trial and Appeal Board of the United
8 States Patent Office, Opposition No. 91198117, which is expected to be stayed pending the
9 resolution of this case.

10 **X. RELIEF**

11 **Plaintiff's Contention**

12 eBay contends that it is entitled to a judgment that Defendants have diluted and infringed
13 the famous EBAY mark and that the infringement was willful. As a result, eBay contends that it
14 is entitled to any and all revenues and profits that Defendants have derived from their wrongful
15 actions and to pay all damages that eBay has sustained by reason of the acts complained of, to an
16 injunction against any further infringement, to an order directing the United States Patent and
17 Trademark Office to cancel Defendants' application to register the BEAUTY BAY mark, Serial
18 No. 77/855,722, and to a judgment ordering Defendants to deliver up for destruction all infringing
19 matter under Defendants' control. eBay is also requesting that any damage award be trebled as a
20 result of Defendants' willful infringement and that Defendants be ordered to pay prejudgment
21 interest as well as eBay's costs and attorneys' fees.

22 **Defendants' Contention**

23 Defendants deny all of Plaintiff's contentions above. Defendants seek an order dismissing
24 all of Plaintiff's claims; declaratory judgment that Defendants do not infringe or dilute Plaintiff's
25 mark; an injunction against Plaintiff's attempts to oppose Defendants' registrations of their marks;
26 and costs of suit, including attorneys' fees.

27 ///

XI. SETTLEMENT AND ADR

The parties are currently discussing settlement, and their preferred form of ADR is private mediation in the future, in the event that the present settlement discussions are not fruitful.

XII. CONSENT TO USE MAGISTRATE JUDGE

The parties have not consented to the assignment of this case to a United States Magistrate Judge for trial and disposition. Dkt. No. 6.

XIII. SCHEDULING

eBay's Proposal: Plaintiff proposes the following schedule for the case.

Event	eBay's proposed dates
Joint CMC Statement	12/9/2013
CMC Hearing	12/13/2013
Proposed fact discovery cutoff	01/30/2015
Disclosure of experts (expert reports) due	2/27/2015
Proposed expert discovery cutoff	4/10/2015
Proposed last date for motions	5/22/2015
Proposed pretrial hearing	7/10/2015
Proposed trial start	7/20/2015

Dotcom's Proposal: Defendants propose the following schedule for the case.

Event	Dotcom's proposed dates
Joint CMC Statement	12/9/2013
CMC Hearing	12/13/2013
Proposed fact discovery cutoff	10/31/2014
Disclosure of experts (expert reports) due	11/30/2014
Proposed expert discovery cutoff	2/27/2015
Proposed last date for motions	3/8/2015
Proposed pretrial hearing	6/5/2015
Proposed trial start	6/15/2015

XIV. TRIAL

A jury demand has been made. The parties estimate that the trial of this matter will require 7 to 10 days.

XV. DISCLOSURE OF NON-PARTY INTERESTED ENTITIES OR PERSONS

Plaintiff eBay has filed its Certifications of Interested Entities or Persons. Dkt. No. 2. eBay further states that as of this date, other than itself, there is no other interest to report pursuant to Local Rule 3-16. Defendants have filed their Certifications of Interested Entities or Persons. Dkt. No. 19. Defendants further state that Beautybay.com Limited is wholly owned by Dotcom Retail Limited. Dotcom Retail Limited is wholly owned by David Gabbie and Arron Gabbie.

Dated: December 9, 2013

HOGAN LOVELLS US LLP

By:/s/ Jennifer M. Lantz

Jennifer M. Lantz
Attorneys for Plaintiff
EBAY INC., a Delaware corporation

Dated: December 9, 2013

COBLENTZ PATCH DUFFY & BASS LLP

By:/s/ Jeffrey Knowles

Jeffrey Knowles
Attorneys for Defendants
DOTCOM RETAIL LIMITED and
BEAUTYBAY.COM Limited

Civil Local Rule 5.1 Attestation

I hereby attest that concurrence in the filing of the document has been obtained from each of the other Signatories.

By:/s/ Jennifer M. Lantz

Jennifer M. Lantz
Attorneys for Plaintiff
EBAY INC., a Delaware corporation